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<div>7590 09/13/2007</div> <div>DERGOSITS &amp; NOAH LLP</div> <div>Suite 1450</div> <div>Four Embarcadero Center</div> <div>San Francisco, CA 94111</div>				
			EXAMINER	
			VALENTI, ANDREA M	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

**MAILED**

SEP 13 2007

Application Number: 10/801,240  
Filing Date: March 15, 2004  
Appellant(s): LAMSTEIN, AARON M.

**GROUP 3600**

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Michael E. Dergosits  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 25 June 2007 appealing from the Office action mailed 07 March 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief:  
Worldwise, Inc.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

**NEW GROUND(S) OF REJECTION**

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,305,318 to Ford in view of U.S. Patent No.6,435,133 to Wayne.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,435,133

Wayne

08-2002

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,305,318 to Ford in view of U.S. Patent No. 6,435,133 to Wayne.

Regarding Claim 1, Ford teaches a pet bed for use by cats (Col. 1 line 11), said pet bed comprising a resilient, compressible fill material (#13), and an outer shell fabric (#2) defining the geometry of the pet bed as having a bottom and sides and a top, the later comprising a gas permeable fabric (Col. 2 line 24-29), a closable opening in said outer shell fabric allowing for selective access to the interior of said outer shell fabric (Fig. 2 #9), a gas permeable pouch (#19) containing catnip located beneath said top fabric such that scent from said catnip is caused to permeate through the said gas permeable pouch and gas permeable top fabric.

Ford teaches a canvas-like fabric (Ford denim Col. 2 line 28), but is silent on explicitly teaching a plush fabric. However, Wayne teaches a pet bed for use by cats that has a plush fabric surface (Wayne Col. 3 line 29 and Col. 4 line 7-8). Wayne teaches it is known to substitute a plush fabric for a canvas-like fabric. It would have

been obvious to one of ordinary skill in the art to modify the teachings of Ford with the teachings of Wayne at the time of the invention to create a more comfortable bed for the animal. The modification is merely the selection of a known alternate material for intended use [Leshin 125 USPQ 416] to obtain predictable results.

Regarding Claim 2, Ford as modified teaches the said gas permeable pouch (#19) containing catnip is located between said resilient compressible fill material and said top fabric (Fig. 5).

Regarding Claims 8 and 9, Ford as modified inherently teaches that said top fabric is depressed by the weight of the cat using said pet bed, scent from said catnip is caused to permeate through said gas permeable pouch and gas permeable top surface or when said gas permeable pouch is squeezed, scent from said catnip is caused to permeate through said gas permeable pouch and gas permeable top surface occurs when the animal is present on top of the bed.

Regarding Claim 3, Ford as modified is silent on the gas permeable pouch containing catnip is located beneath said resilient compressible fill material. However, it would have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention since the modification is merely the shifting location of a known element performing the same intended function and does not present a patentably distinct limitation [*In re Japikse*, 181 F.2d 1019, 1023, 86 USPQ 70, 73 (CCPA 1950)].

Regarding Claims 5 and 7, Ford as modified teaches the gas permeable pouch is selectively attachable to an interior surface of said top fabric by providing said interior surface with a fabric pocket sized to receive said pouch (Fig. 5).

Regarding Claim 6, Ford as modified teaches that hook and loop fasteners are a known means of securing things in place (#9), but is silent on said gas permeable pouch is selectively attachable to an interior surface of said top fabric by hook-and-loop fasteners. However, it would have been obvious to one of ordinary skill in the art to modify the teachings of Ford at the time of the invention with a known fastening means to prevent the catnip from becoming undesirably displaced.

Regarding Claim 4, Ford as modified is silent on said gas permeable pouch is characterized as having a closable opening so that catnip can be periodically refillably introduced to said pouch. However, it is old and notoriously well-known to provide recyclable pouches as an environmentally sound practice to reduce waste. It would have been obvious to one of ordinary skill in the art to modify the teachings at the time of the invention for the cost reducing and environmentally beneficial results.

#### **(10) Response to Argument**

Applicant argues that Ford does not teach placing a pouch containing catnip beneath a gas permeable fabric or to provide a closable opening in an outer shell fabric allowing for selective access to the interior of the outer shell fabric for placement of a gas permeable pouch containing catnip. However, in applicant's independent claim, applicant has not claimed that the catnip is placed in the closable opening. Applicant has claimed the structural feature of closable opening, which Ford does teach. Ford teaches a closable opening around the waistband (Ford Fig. 2 #9 and Col.2 line 36-42). Applicant has merely claimed that the gas permeable pouch is located beneath the top fabric. Applicant has not claimed that the gas permeable pouch is placed in or intended

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to be placed in the closable opening. Ford does teach that the gas permeable pouch is located beneath the top fabric (Ford Fig.5 #19) since Ford places the pouch in a pocket. The top surface of the pocket is considered to be part of the top fabric of the bed since the pocket is constructed out of the material that is identical to the material covering the fill material. By being in the pocket of Ford, the pouch is under the top fabric.

Applicant argues that Ford does not teach placing the gas permeable pouch containing catnip between the resilient fill material or beneath the compressible fill material and the top fabric. However, the examiner maintains that Ford teaches a resilient compressible fill material (Ford Col. 2 line 57-59) and a shell fabric (Ford Col. 2 line 25-27 element #2). In claim 2, applicant has merely claimed that the catnip is located between the fill material and the top fabric. Examiner maintains that by Ford teaching that the catnip pouch is placed in the pocket it is located between the top layer (i.e. the outer layer of the pocket) and the fill material (Ford, fill material located under the pocket). Applicant has not claimed that the catnip is in direct contact with the fill material. The current wording of the claim can lend to the interpretation that there can be many layers between the catnip and the fill material and if there were many layers that catnip would still be "between" the top fabric and the fill material. In claim 3, applicant has merely claimed the catnip is located beneath the fill material. Applicant has not claimed the orientation of the bed; therefore, if the bed got turned upside down the catnip inherently would be located under the fill material. Thus it is merely a relative limitation to the orientation of the pillow.

Applicant argues that the examiner has ignored the limitation that the gas permeable pouch containing the catnip is retained within the closable opening in the outer shell of the fabric. However, applicant **has not** claimed this limitation. Applicant claims a closable opening, but does not claim the relationship of the gas permeable pouch to the opening.

Claims 8 and 9 are merely functional language claims that fail to further limit the independent claim since it is an apparatus claim and weight is not given to method steps in an apparatus claim. Ford is capable of performing the functions intended in claims 8 and 9.

Applicant's claim 4 states that the gas permeable pouch has a closable opening. Ford teaches a gas permeable pouch with a closable opening (Ford Col. 2 line 60-65). Ford teaches the opening is stitched closed; however, the opening is functionally "capable of" being unstitched to empty and refill the pouch.

Claims 5, 6, and 7 state the limitations that the gas permeable pouch is "selectively attachable to". This is functional language. The gas permeable pouch taught by Ford (Ford #19) is "capable of" being attached to an interior surface of the top fabric via hook-and-loop fasteners or via a fabric pocket.

The examiner generated a new grounds of rejection in the examiner's answer to explicitly address the limitation that the top fabric is a plush fabric. Upon closer review of the Ford patent the examiner determined that Ford taught a Denim-like material but did not explicitly teach plush. However, the Wayne reference teaches it is general knowledge of one of ordinary skill in the art to substitute plush fabrics for canvas-like



fabrics on pet beds. It is an obvious modification with predictable results and does not present a patentably distinct limitation.

Examiner maintains that applicant has not patentably distinguished over the teachings of the cited prior art. What applicant argues is different than what is actually recited by the claim limitations.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of

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rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,



Andrea M. Valenti  
Primary Examiner  
Art Unit 3643

**A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:**



Conferees:

Robert Swiatek RPS

Meredith Petravick MP

Andrea Valenti



30 August 2007